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EXAMINER

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3625

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/547,540
Filing Date: April 12, 2000
Appellant(s): ALLOCCA ET AL.

MAILED

SEP 14 2006

GROUP 3600

James A.D. White
For Appellant

EXAMINER'S ANSWER

This is in response to the Order returning undocketed Appeal to Examiner from BPAI dated 8/28/2006 in order to include the "References of Record" in the Examiner's Answer.

Art Unit: 3625

Request for reinstatement of appeal brief filed 6/2/2004 appealing from the Final Office action mailed on 3/2/2004.

Note: The appeal brief reinstated on 6/2/2004 complies with the old format set forth in CFR 1.192 and not with 37 CFR § 41.37 (c) the format set forth on September 16, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct except for the statement that claims 1-8 and 52 are rejected under 35 USC 112, first paragraph. The examiner withdrew this rejection of claims 1-8 and 52 are rejected under 35 USC 112 in the Office action mailed on 3/2/2004.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

Art Unit: 3625

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct (see section VII ISSUES on pages 7-8 of the Appeal Brief).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,960,411	HARTMAN et al.	9-1999
6,336,100 B1	YAMADA	1-2002
6,493,742 B1	HOLLAND et al.	12-2002

OFFICIAL NOTICE

(9) Grounds of Rejection

The ground(s) for rejection are reproduced below from the Final Office Action, mailed on 3/2/2004, and are provided here for the convenience of both the Appellant and the Board of Patent Appeals:

Quote: "

Response to Appeal Brief

1. Applicant's appeal brief, paper # 16, is acknowledged and entered. The applicant's arguments filed on 12/08/2003 on pages 27-30 of the appeal brief are persuasive concerning rejection of claims 1-8 and 52 under 35 U.S.C. 112, first paragraph submitted in the last Final action and, therefore, the finality of that action is withdrawn. No amendments have been made. Currently claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 are pending.

.....
Claim Rejections - 35 USC § 103

Art Unit: 3625

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman, in view of Yamada (US Patent 6,336,100 B1). Note: rejection of claims 1-7 and 52 is being done in the light of 35 U.S.C. 112, first paragraph rejection made above.

With regards to 1, 9, 10, 29, 31, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68, Hartman discloses a method, a system, a computer-readable medium, and a display device for assisting a user at a client system to place an order for an item to be received by a server system. The client system displays the information identifying the item, an element representing order fulfillment instructions for the identified item, receiving indication of the recipient with predefined order fulfillment information including a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source/information, such that the payment information for procurement option will be used to pay for the identified item and such that delivery information for that procurement option will be used for the delivery of the identified item, and after selection by the user of a displayed indication, without further intervention, sending to server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected recipient using the shipping instructions and to be paid for by the payment source for the selected recipient, so that a single action orders and pays for the item (see at least FIGS 1A-1C, 2-7, 8A-8C, col.2, line 50-col.9, line 53. Note: In FIG.1C, reference number 108 discloses a "Ship to", "Shipment Method: Standard Domestic Shipping", and a "Payment Method" information. In Hartman, "Shipment Method: Standard Domestic Shipping" corresponds to the claimed shipping instructions along with the payment and delivery information to "John Doe at Home". The combination of ship to instructions, shipment method instructions and payment instructions correspond to an unique combination of delivery, shipping instructions different from delivery address and payment source/information).

Hartman also teaches to create new procurement option for ordering the identified item (see at least Fig.1B, "...Review or change your 1-click orders", col.4, line 59-col.5, line 8). Hartman further teaches that a client identifier corresponds to multiple customers and these multiple customers can be identified by selecting a partially displayed purchaser-specific order information (see at least col.9, lines 54-63).

Hartman does not expressly teach displaying multiple groups/procurement options associated with a single user of the client system having information related to ordering the identified item. Yamada, in the same field of online shopping, teaches displaying multiple groups/procurement options associated with a single user of the client system having information related to ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30. Disclosing several predefined choices for delivery destination clearly corresponds to multiple pre-defined procurement options and satisfies the limitation recited in the independent claims 1, 10, and 29). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to display multiple groups/procurement options having information related to ordering the identified item as expressly taught in Yamada. Thus, when Yamada is combined with Hartman, for each different delivery address, would result in unique combinations of delivery address, shipping instructions different from delivery address, and payment source/information. Doing so would allow the user the novelty and the convenience to order items online for different destinations for him and/or gifts for individuals other than him (see at least col.1, lines 11-44, and col.3, lines 6-19). Note: different

Art Unit: 3625

destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col.1, lines 11-44, and col.3, lines 6-19).

Hartman/Yamada further teaches all the limitations cited in claims 2-7, 13, 15-27, 30, 35, 37, 38, 51-55, 57-58, 60-63, 65, and 129, (see Hartman, col.2, line 51-col.10, line 14, and Yamada, col.1, line 19-col.5, line 20).

3.2 Claims 8, is rejected under 35 U.S.C. 103(a) as being obvious over Hartman/Yamada in view of Official Notice.

With regards to claim 8, Hartman/Yamada teaches a method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information as disclosed in claim 1 and analyzed above. Hartman/Yamada does not disclose displaying an indication selecting a default groups out of the identified multiple groups. Official Notice is taken of both the well-known concept and benefits of providing a default program while working on the computers when several choices are available to the user to select one. If a user does not specify an alternative the program makes a choice automatically. In view of this well-known concept and its benefits it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include default program in Hartman/Yamada because if a user wants the purchased item to be delivered at his home then he can save time by not being bothered to select delivery information (see at least Yamada, Fig.9, col.3, lines 6-19) as the default program will automatically indicate the server in Hartman/Yamada to select home address if the user has not made any selection of the available multiple groups.

3.3. Claims 14, and 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada in view of Holland et al. (US Patent 6,493,742), hereinafter referred to as Holland.

With regards to claims 14, and 36, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claims 10, and 33, and analyzed above. Hartman/Yamada discloses indicating a selection of an option to deliver the item as a gift (see at least Yamada col3., lines 6-12). Hartman/Yamada does not disclose that the order request includes wrapping instructions for the item to be delivered. As per knowledge generally available wrapping gifts before delivering to the recipients is notoriously well known practice. In the same field of on online ordering gifts, Holland teaches including wrapping instructions while ordering a gift (see at least col.1, lines 26-46). In view of Holland and knowledge generally available it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include the wrapping.

“ Unquote:

(10) Response to Argument

A. None of the Cited References teaches or suggests using multiple predefined procurement options to assist a user in ordering an item, with each procurement option having associated information of multiple types including at least payment information and delivery information.

The applicant argues (see appeal brief, pages 12-16) (a) that the

Art Unit: 3625

examiner has failed to establish a prima facie case of obviousness because none of the cited references teach alone or in combination using multiple predefined procurement options while ordering using a computerized system and that each procurement option have associated information of multiple types including at least payment information and delivery information, (b) there is no motivation to combine the references of Hartman and Yamada, and (c) even if the Examiner had established a motivation to combine the techniques from Hartman and Yamada, the resulting combination would not have multiple predefined procurement options that each have sufficient information to complete the order for an item so as to enable the ordering of an item merely by selecting any of the predefined procurement options, and in particular would not have multiple predefined procurement options that each have associated information of multiple types including at least payment information and delivery information, as recited.

The examiner respectfully disagrees. Reference Hartman explicitly teaches using a computerized system for ordering items such FIG.1C, reference number 108 discloses a " Ship to" , "Shipment Method", and a "Payment Method " information.). The examiner acknowledged that the Hartman reference does not disclose using multiple predefined procurement options. However, this missing limitation is clearly suggested in the Yamada reference, which is also directed to the same field of endeavor of electronic commerce, see at least the following Figures and segments from Yamada reference::

FIG. 2 (see "Step 7-Select Place where to deliver"), FIG. 4 (see " Station Setting "), FIG.5 (see the various options provided for choosing a delivery destination), FIG.6 (discloses several predefined choices for delivery destination), FIG.9 ((discloses several predefined choices for delivery destination).

col.1, lines 12-44 "*The present invention provides an online shopping system comprising: a server.....and a plurality of pieces of customers' terminal equipment electrically connected to the server,, order information transmitted from the terminal equipment to the server when the order is made including delivery information indicating at least either one of each customer's place of residence, customer's designated place, a place where the commodity is kept temporarily or each customer's designated person's place of residence as a place where the commodity should be delivered.* ". Also see col.3, lines 6-18, and col.4, lines 27-31.

Disclosing a plurality of predefined choices for shipping destinations for each buyer clearly corresponds to multiple pre-defined procurement options and satisfies the limitation recited in the independent claims 1, 10, and 29 and also the similar limitations in claims 9, 31, 32, 33, 40, 41, 50, 56 and 59. Combination of Yamada and Hartman teachings would result for a buyer providing predefined plurality of destination options, as exhibited in Yamada, and each choice of the destination option would include a " Ship to" , "Shipment Method", and a "Payment Method " information as disclosed in Hartman , see FIG.1C, reference number 108 resulting in multiple types of information associated for each

Art Unit: 3625

predefined procurement option at least including a delivery information and a payment information.

The Examiner's motivation in combining the teachings Hartman and Yamada, see Final action, page 8, was that the incorporation of Yamada's feature of using multiple predefined choices for delivery information will present multiple choices to the buyer to be able to select a delivery destination from one of the following, his residence, office place, a convenience store from where he can collect the item as per his convenience, or a delivery destination for sending the procured item as a gift to a friend's address (see Yamada and the analysis presented above).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. As analyzed above, Hartman did not disclose displaying multiple groups/procurement options having information related to ordering the identified item but Yamada teaches displaying multiple groups/procurement options having information related to ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30,). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify

Art Unit: 3625

Hartman to display multiple groups/procurement options having information related to ordering the identified item as expressly taught in Yamada. Doing so would allow the user the choices to order items online for different destinations for him and/or gifts for individuals other than him). Note: different destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col.1, lines 11-44, and col.3, lines 6-19). See the following related court cases for combining references :

In re McLaughlin, 170 USPQ 209 (CCPA 1971)

"Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper."

In re Sheckler, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

Ex parte Clapp, 227 USPQ 972 (BdPatApp&Int 1985)

"To support conclusion that claimed combination is directed to obvious subject matter, references must either expressly or impliedly suggest claimed combination or examiner must present convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of references' teachings."

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

Art Unit: 3625

In re Gershon, Goldberg, and Neiditch, 152 USPQ 602 (CCPA 1967)

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

In re Beattie, 24 USPQ2d 1040 (CA FC 1992)

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

In re Dillon, 16 USPQ2d 1897 (CA FC 1990)

"Each situation must be considered on its own facts, but it is not necessary in order to establish a prima facie case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or a similar utility as one newly discovered by applicant."

Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193 (CA FC 1983)

"Fact that two disclosed apparatuses would not be combined by businessmen for economic reasons is not same as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on nonobviousness issue. "

B. In addition to failing to teach or suggest the use of multiple predefined procurement options that each have associated information of multiple types, none of the cited references teaches or suggests each of several additional recited claim elements.

The examiner respectfully disagrees. It is already analyzed above that Hartman/Yamada does teach/suggest the use of multiple predefined procurement options that each have associated information of multiple types.

Art Unit: 3625

The reference Hartman/Yamada also teaches the additional elements.

1. The applicant argues (see appeal brief, pages 17-19) that the procurement option selected to order the item further includes "shipping instructions" along with the payment and delivery information such that the ordering request for an item based on the selected procurement option is additionally to deliver the item as specified by the shipping instructions. The examiner disagrees because combined teachings of Hartman/Yamada teaches this limitation about shipping instructions (See Hartman at least FIG.1C, reference number 1080) which discloses a " Ship to" , "Shipment Method: Standard Domestic Shipping", and a "Payment Method " information. In Hartman, , "Shipment Method: Standard Domestic Shipping" corresponds to the claimed shipping instructions along with the payment and delivery information to " John Doe at Home".

The applicant's argument, (see Appeal Brief page 18, line 21- page 19 line 6) that since the examiner has referred to the entire detailed description and summary sections of Hartman and Yamada it is not possible for the appellants to comment on examiner's basis for rejection is no more relevant because the examiner provided the above basis in the Final office action mailed on 3/2/2004 on page 4). The applicant further argues that if even Hartman did disclose these limitations the Examiner has not provided a suggestion or motivation to transform Yamada's teachings. In response, the examiner would like to state that the rejection is made as the claims are unpatentable over Hartman in view of Yamada and not that the claims are unpatentable over Yamada in view of

Hartman. Since the primary reference Hartman teaches the additional limitations regarding "shipping instructions", as shown above and earlier in the final Office action there is no need for providing a motivation to combine the teachings of Yamada when it has been already provided while rejecting the independent claims.

2. The applicant argues (see Appeal Brief pages 19-21) that none of the cited references teaches or suggests that each of the procurement options includes a "unique combination" of a delivery address, shipping instructions distinct from the delivery address, and a payment source", or each has a "distinct combination" of multiple types of information that is "sufficient to complete an order" for the identified item. The examiner respectfully disagrees. The analysis above in "A" on Yamada reference discloses predefined multiple choices for different delivery addresses/destinations and therefore when Hartman is combined with Yamada the combined art of Hartman/Yamada discloses unique combination of a delivery address- buyer's residence, office place, a convenience store from where he can collect the item as per his convenience, as a gift to a friend's address, as disclosed in Yamada, and shipping instructions and a payment source, as disclosed in Hartman. The motivation to combine Yamada with Hartman is suggested in Yamada as discussed and analyzed above.

The applicant's argument, (see Appeal Brief page 21, lines 11-19) that the examiner has failed to address this claim element because he has generally cited the entire detailed description and summary sections of Hartman and

Art Unit: 3625

Yamada and therefore it is not possible for the appellants to comment on examiner's basis for rejection. The examiner respectfully disagrees as he has addresses this limitation in the final office action mailed on 3/2/2004 on pages 7-8 and has further elaborated it under the heading " Response to Arguments" in the same Final office action mailed on 3/2/2004 on pages 4-5).

3. The applicant argues (see Appeal Brief pages 21-24) that none of the cited references teaches or suggests displaying an additional information to the user along with the displayed indications of the multiple predefined procurement options to allow interactive creation of a new procurement options for use in ordering the item. The examiner respectfully disagrees.

Hartman/Yamada teaches this limitation as elaborated on page 5 of the Final office action mailed on 3/2/2004 under the heading " Response to Arguments".

And refer to Yamada, at least Figs 4-6, and col.4, lines 31-40, " *FIG. 4.*

Station change can be done at this stage. When the customer 3 sets or changes the station 1 and/or 2, he or she selects one of the states listed on lower part of the screen and clicks SET. FIG. 4 indicates that the customer 3 selects New York. The display on the screen changes to a display as shown in FIG. 5 where the customer 3 selects Manhattan. Then, the customer 3 clicks STATION LIST. Several stations (24-hour opened convenience stores) appear on the screen as shown in FIG. 6 where the customer 3 selects one station and clicks STATION 1 or STATION 2. Note: Yamada, here explicitly discloses that the user interactively changes the delivery destination, thereby, creating a new

Art Unit: 3625

option as per his requirement while placing the order and motivation to combine Yamada 's teachings would be the same as analyzed above for independent claim 10 that is, that it would allow the user the choices to order items online for different destinations for him and/or gifts for individuals other than him). Note: different destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col.1, lines 11-44, and col.3, lines 6-19).).

4. The applicant argues (see Appeal Brief pages 24-27) that none of the cited references teaches or suggests that the user can order an item using the item ordering information from one of the procurement options by merely selecting the displayed indication for that procurement option. The examiner respectfully disagrees. Hartman discloses use of 1-click order mechanism, see FIG.1C but it does not disclose using this mechanism for multiple predefined procurement options. However, as analyzed and discussed above Yamada teaches using and displaying multiple predefined procurement options while ordering an item on Internet. It would be obvious to one of an ordinary skilled in the art at the time of the invention to combine Yamada's feature of multiple predefined procurement options with Hartman allowing the users to use a single-click option to select the choice from a number of available choices as taught in Yamada. Doing so will present convenience to the buyer of having multiple predefined procurement options to be able to select for getting the

Art Unit: 3625

ordered item delivered to either his residence, office place, a convenience store from where he can collect the item as per his convenience, as a gift to a friend's address (as disclosed in Yamada) by merely selecting the option, using single-click ordering system to reduce the number of buyer interactions needed to place the order and also to reduce the amount of sensitive information that is transmitted between client system and server (see Hartman, col.3, lines 33-38).

Note: the above analysis was also submitted in the Final office action mailed on 3/2/2004 on pages 5-6.

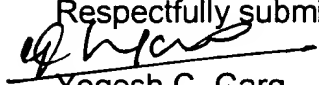
C Appellants' application as filed describes that multiple predefined order fulfillment information groups can each have a "unique combination of a delivery address, shipping instructions distinct from the delivery address and a payment source and that multiple procurement options can each have a unique combination of delivery and payment information.

Since examiner already withdrew rejection of claims 1-8 and 52 under 35 USC 112, first paragraph in the final office action mailed on 3/2/2004 on page 2 this issue and arguments submitted (see Appeal Brief, pages 27-30) are no longer relevant.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

Since the appeal brief reinstated on 6/2/2004 complies with the old format set forth in CFR 1.192 Related Proceeding(s) Appendix is not required.


Respectfully submitted,

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YCG
9/7/2006

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